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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/560,343

12/12/2005

Toshio Yamato

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9369

22428 7590 11/15/2007
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EXAMINER

ZIMMER, MARC S

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

11/15/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/560,343

Applicant(s)

YAMATO ET AL.

Examiner

Marc S. Zimmer

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 12/12/05, 05/19/06
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

At the outset, the Examiner wishes to comment on the findings set out in the International Preliminary Examination Report. The author of that assessment of patentability of the claims indicates that each of references JP 6-25604, JP 11-43647, and JP 2002-188057 discloses a composition mirroring that claimed in virtually every respect with the exception that there is no mention of a chlorinated polyolefin. That person states, nevertheless, that the claimed invention is obvious because two other references cited by the ISA teach the employment of chlorinated polyolefin as adhesion promoters for facilitating more robust bonding of a silicone coating to olefin rubber.

While the present Examiner agrees that the latter two documents motivate the skilled artisan to incorporate chlorinated polyolefin into siloxane-based compositions where they are coated onto olefin rubber substrates (albeit siloxanes that possibly cure by a different mechanism), it does not appear to be true all of the three initially-cited documents anticipate all other aspects of the invention. Indeed, the Examiner does not see any mention of a component equivalent to the spherical rubber particles (F) in any of 6-25604, JP 11-43647, and JP 2002-188057. Further, it is noted that the compositions disclosed in the first two of these are formulated as solutions in an organic carrier.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention. At issue is Applicant's description of the particles (F) as "rubber-like". This phrase provokes questions as to what are the particles if not rubbers? Clarification is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shimozu, JP 2002-188057 in view of either Fujii, JP 9-165548 or Matsumoto et al., JP 2001-207106 and also Inokuchi et al., U.S. Patent # 5,527,841. Shimozu teaches a polysiloxane-based, waterborne coating agent containing every element of the claimed composition except for the chlorinated polyolefin component and rubber particle component. To reiterate, Fujii and Matsumoto both indicate that chlorinated polyolefin may be used to enhance adhesion between an aqueous polysiloxane coating and an olefin rubber. Significantly, it is a primary objective of Shimozu to develop an aqueous polysiloxane coating for the purpose of covering an olefin rubber substrate.

Of course, each one of these references is silent concerning the incorporation of rubber particles. However, Inokuchi teaches yet another coating composition for treating rubber substrates comprising a curable polysiloxane and, relevant to the present discussion, it is contemplated therein that an aqueous dispersion of cured silicone rubber particles may be added for the purpose of increasing the lubricity of the

coating and, hence, the lubricity of the coated substrate. (In the background section of column 1, it is mentioned that, where the lubricity is not sufficient, an objectionable noise will be heard when a movable part slides along the surface of the rubber part due to undesirably high friction between the parts, e.g. when the rubber part is a seal around a movable window.) Further, Inokuchi teaches the employment of quantities of the silicone rubber particles consistent with that being claimed in claim 4 at column 9, lines 50-60. See also column 6, lines 51-64.

As for claim 3, insofar as the amount of this material to be used is inarguably a result-effective variable, one of ordinary skill would optimize this parameter as a matter of routine experimentation.

As an aside, Applicant advocates the use of silicone rubber particles as an embodiment of the component (F) in paragraph [0046] of their Specification. Therefore, it is the position of the Examiner that the hardness limitation is inherently satisfied, particularly given the identical role of said particles in the Inokuchi disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc S. Zimmer whose telephone number is 571-272-1096. The examiner can normally be reached on Monday-Friday 8:30-5:00.

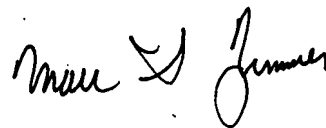
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Application/Control Number:
10/560,343
Art Unit: 1796

Page 5

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

November 9, 2007

A handwritten signature in black ink, appearing to read "Marc S. Zimmer". The signature is fluid and cursive, with the first name "Marc" and last name "Zimmer" clearly distinguishable.

MARC S. ZIMMER
PRIMARY EXAMINER